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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,219	04/09/2001	Antonio Montserrat Gibernau	932.1194	8578
21831	7590	03/08/2005	EXAMINER	
STEINBERG & RASKIN, P.C. 1140 AVENUE OF THE AMERICAS, 15th FLOOR NEW YORK, NY 10036-5803			MADSEN, ROBERT A	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/829,219	MONTSERRATE GIBERNAU, ANTONIO	
	Examiner	Art Unit	
	Robert Madsen	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 September 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on April 9, 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>January 7, 2005</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. The Amendment filed December 7, 2004 has been entered. Claims 1-15 remain pending in the application.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 5,11,13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Levinson (US 4390554) as evidenced by Waddell (US 6464104 B1)

4. See rejection (i) in the Office Action Mailed September 7,2004.

5. Currently amended claims 1 and 15 further recite the "packaging assembly is used in automatic dispensing machines equipped with microwave ovens." This is an intended use limitation, and if Levinson is capable of performing the intended use, then it meets the claim. Levinson teaches a frozen package assembly that is capable of commercial and vending feeding (Column 2, lines 42-47), and Waddell is relied on as evidence that a frozen package assembly *is* capable of being used with automatic dispensing vending machines equipped with microwave ovens (Abstract, Column 2, line 44 to Column 3, line 15).

6. Claims 1, 5, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Levinson (US 4390554), as evidenced by Waddell (US 6464104 B1).

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7. See rejection (ii) in the Office Action Mailed September 7,2004.
8. Currently amended claims 1 and 15 further recite the “packaging assembly is used in automatic dispensing machines equipped with microwave ovens.” This is an intended use limitation, and if Levinson is capable of performing the intended use, then it meets the claim. Levinson teaches a frozen package assembly that is capable of commercial and vending feeding (Column 2, lines 42-47), and Waddell is relied on as evidence that a frozen package assembly *is* capable of being used with automatic dispensing vending machines equipped with microwave ovens (Abstract, Column 2, line 44 to Column 3, line 15).

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
10. Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being over unpatentable Levinson (US 4390554) as evidenced by Waddell (US 6464104 B1), as applied to claims 1,5,11,13, and 15 in rejection (i), further in view of Cox (US 5679278).
11. See the Office Action mailed September 7, 2004.
12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levinson (US 4390554) as evidenced by Waddell (US 6464104 B1), as applied to claims 1,5,11,13, and 15 in rejection (i), further in view of Smart et al. (US 4890439).
13. See the Office Action mailed September 7, 2004.

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levinson (US 4390554) as evidenced by Waddell (US 6464104 B1), as applied to claims 1,5,11,13, and 15 in rejection (i), further in view of Borek (US 4219573).

15. See the Office Action mailed September 7, 2004.

16. Claims 2,7,10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levinson (US 4390554) as evidenced by Waddell (US 6464104 B1), as applied to claims 1,5, and 13 in rejection (ii), further in view of Borek (US 4219573).

17. See the Office Action mailed September 7, 2004.

18. Claims 1,4-6,12,13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engstrom et al. (US 4734288) in view of Anderson (US 4950859).

19. See the Office Action mailed September 7, 2004.

Response to Arguments

20. Applicant's arguments filed December 7, 2004 have been fully considered but they are not persuasive.

21. With respect to the rejection of claims under 35 USC 102(b) and 35 USC 103(a) and Levinson, Applicant argues that Levinson does not teach the new limitation "packaging assembly is used in automatic dispensing machines equipped with microwave ovens" of currently amended claims 1 and 15 and that a frozen food

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package is not suitable with automatic dispensing machines. However, as discussed above in the rejections under 35 USC 102(b), Levinson does teach the product is suit for commercial or *vending* feeding , and Waddell does teach frozen food packages are suitable with automatic dispensing machines equipped with microwave ovens. Furthermore, Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In the instant case, it has been shown that frozen food packages are suitable for automatic dispensing machines equipped with microwave ovens.

22. Applicant also argues that Levinson does teach a package not suitable for use with a food product such as popcorn because of the perforated film, and popcorn requires the humidity and organoleptic qualities be preserved until it is heated. However, it is noted that the features upon which applicant relies (i.e., a food product such as popcorn or a non-perforated film) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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23. With respect to the rejection of claims 1,4-6, 12,13 under 35 USC 103(a) as being unpatentable over Engstrom et al. in view of Anderson, Applicant argues that Engstrom et al. do not teach an outer package which is melted during its heating and that Anderson does not teach a heat-concentrating material which melts any portion of a microwave package. The Examiner stated in Paragraph 24 in the Office Action mailed September 7,2004 that Engstrom et al. teach an inner plastic popcorn wrapper (item 29) and an outer package of plastic material. The Examiner stated that the polyethylene layer (i.e. item 22), which is a solid at room temperature ,melts during the heating process , and completely surrounds the inner wrapper, was considered the outer package. This outer package is covered on its outer surface by a paperboard-based substrate(See Column 5, line 37 to Column 6, line 14). Anderson is relied on for teaching including heat-concentrating material inside a plastic popcorn bag (i.e. in contact with the popcorn) to increase cooking efficiency, and thus provides motivation for including a heat concentrating material inside the inner popcorn wrapper of Engstrom et al.: improve the microwave heating efficiency of popcorn in a plastic package.

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (571) 272-1402. The examiner can normally be reached on 7:00AM-3:30PM M-F.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Madsen
Examiner
Art Unit 1761

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